



Docket No.: 161892US2CONT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 09/457,669

Applicants: Tetsuro MOTOYAMA

Filing Date: December 9, 1999

For: METHOD AND SYSTEM FOR DIAGNOSIS AND
CONTROL OF MACHINES USING CONNECTION
AND CONNECTIONLESS MODES OF
COMMUNICATION

Group Art Unit: 2142

Examiner: PRIETO, BEATRIZ

SIR:

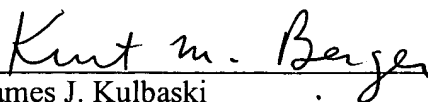
Attached hereto for filing are the following papers:

Reply Brief

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 5244-0117-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TETSURO MOTOYAMA : EXAMINER: PRIETO, BEATRIZ
SERIAL NO: 09/457,669 :
FILED: DECEMBER 9, 1999 : GROUP ART UNIT: 2142
FOR: METHOD AND SYSTEM FOR :
DIAGNOSIS AND CONTROL OF
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COMMUNICATION

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant respectfully replies to the Examiner's Answer dated July 5, 2006.

In the Office Action dated July 26, 2005, all of the pending claims in the present application were finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,537,626 to Kraslavsky et al. (hereinafter "the '626 patent"). This rejection was addressed by Applicant in the Appeal Brief filed January 17, 2006. In the Examiner's Answer, however, the Examiner set forth a new ground of rejection based on two additional references. In particular, all of the pending claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over the '626 patent¹ in view of U.S. Patent No. 6,003,070 to Frantz et al.

¹ Applicant notes that the Examiner's Answer cites "Kraslavsky et al. (U.S. 6,889,263) (Kraslavsky hereafter)." However, as stated in the Appeal Brief, U.S. Patent No. 6,889,263 was granted to Motoyama, not Kraslavsky et al. Since the Examiner's Answer repeatedly cites to Kraslavsky in the Office Action, Applicants have again interpreted the reference to U.S. Patent No. 6,889,263 to be an inadvertent error.

(hereinafter "the '070 patent") and U.S. Patent No. 5,506,834 to Sekihata et al. (hereinafter "the '834 patent").

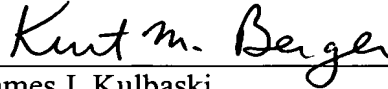
Applicant respectfully submits that the Examiner's Answer dated July 5, 2006, improperly sets forth a new ground of rejection of all of the pending claims. 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an Examiner's Answer. Here, the Examiner has changed the statutory grounds of rejection from 35 U.S.C. § 102(b) to 35 U.S.C. § 103(a). Further, as stated in MPEP § 1208.01, "[a] new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection." The '834 patent was cited by the Examiner for the first time on a Form PTO-892 mailed with the Examiner's Answer. Accordingly, Applicant respectfully submits that an impermissible new ground of rejection has been set forth in the Examiner's Answer dated July 5, 2006.

Further, even assuming *arguendo* that the rejection set forth in the Examiner Answer is permissible, Applicant respectfully submits that the new statement of rejection does not establish a *prima facie* case of obviousness because the '070 patent is not a valid prior art reference. The '070 patent was filed February 25, 1997, and does not claim the benefit of priority to any other U.S. patent application. The present application claims priority under 35 U.S.C. § 120 to U.S. Patent Application Nos. 08/916,009, filed August 21, 1997, and 08/463,002, filed June 5, 1995. Accordingly, Applicant respectfully submits that the statement of rejection set forth in the Examiner's Answer does not establish a *prima facie* case of obviousness and should be withdrawn.

For the reasons stated above and the reasons set forth in the Appeal Brief filed
January 17, 2006, Applicant submits that the Final Rejection should be reversed.

Respectfully submitted,

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